

### **REMARKS**

Applicant submits this Amendment and Response in reply to a non-final Office Action mailed on September 28, 2006.

Claims 1-30 are pending in the application. In the Office Action, claim 24 is objected to for depending from claim 13, when it appears that it should depend from claim 23. Claims 1-30 are rejected under 35 U.S.C. § 112, second paragraph. Claims 1-30 are rejected under 35 U.S.C. § 101 for the following reasons: (1) claims 1-30 allegedly fail to provide a useful and tangible result (no execution or returning of results); (2) claims 23-30 provide no means for executing the program code claimed; and (3) “claims 23-30 fail to meet (sic) the tangibility requirements as the specification states, ‘Embodiments of CRM for memories 108 and 156 include, but are not limited to, an electronic, optical, magnetic, or other storage or transmission device,’ and transmission type media (i.e., carrier waves) are not tangible.” *Office Action*, page 3. Claims 1, 2, 3, 5, 9, 23-25, and 28 stand rejected to under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Publication No. 2005/0222975 to Nayak (hereinafter “Nayak”). Claims 1-10, 20, and 22-30 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. 6,006,225 to Bowman (hereinafter “Bowman”). Claims 11-19 and 21 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bowman in light of Nayak. Applicant respectfully traverses the rejections.

Applicant has amended the specification and claims 1, 2, 3, 23, 24, and 25. Applicant makes these amendments without prejudice or disclaimer. In making these amendments, Applicant has added no new matter. Support for the amendments above can be found in the specification and claims as filed. Reconsideration of the pending claims is respectfully requested in view of the foregoing amendments and the following remarks.

#### **I. Amendments in the Specification**

Applicant has updated paragraphs 0016 and 0022 to correct two obvious typographical errors.

## **II. Claim 24**

In the *Office Action*, claim 24 is objected to for depending from claim 13, when it appears that it should depend from claim 23. Applicant has amended claim 24 to depend from claim 23. Applicant respectfully requests that the objection to claim 24 be withdrawn.

## **III. Claims 1-30 and 35 U.S.C. § 112, second paragraph**

Claims 1-30 are rejected under 35 U.S.C. § 112, second paragraph. The *Office Action* states that claims 1 and 23 contain the phrase “substantially identical,” which renders the claims indefinite. The *Office Action* states that claims 2 and 3 contain the “substantially identical” phrase as discussed above and the term “the backend search system,” which lacks antecedent basis.

In the amendments above, Applicant has amended claims 1, 2, 3, 23, 24, and 25, replacing the phrase “substantially identical” with the term “match.” Support for this term may be found, for example, in the specification at paragraph 0037. Applicant has deleted the term “the backend search system” from claims 2 and 3.

Applicant respectfully requests that the Examiner withdraw the rejection of claims 1, 2, 3, 23, 24, and 25. Claims 4-22 and 26-30 depend from and further limit claims 1 and 2, respectively. Applicant respectfully requests that the rejection of claims 4-22 and 26-30 be withdrawn as well.

## **IV. Claims 1-30 and 35 U.S.C. § 101**

Claims 1-30 are rejected under 35 U.S.C. § 101 for the following reasons: (1) claims 1-30 allegedly fail to provide a useful and tangible result (no execution or returning of results); (2) claims 23-30 provide no means for executing the program code claimed; and (3) “claims 23-30 fail to meet (sic) the tangibility requirements as the specification states, ‘Embodiments of CRM for memories 108 and 156 include, but are not limited to, an electronic, optical, magnetic, or other storage or transmission device,’ and transmission type media (i.e., carrier waves) are not tangible.” *Office Action*, page 3.

Applicant will address each ground of this rejection in turn. According to the *Office Action*, Claims 1-30 allegedly fail to provide a useful and tangible result because there is “no

execution or returning of results.” *Id.* However, independent claims 1 and 23 explicitly recite “issuing a search of the modified second search query having the substituted modified search query **to return one or more search results** as responsive to the received second search query.” Such a method provides a useful and tangible result.

The *Office Action* states “claims 23-30 provide no means for executing the program code claimed.” *Office Action*, page 3. Claims 23-30 are “computer-readable medium” claims, and not “means for executing” is necessary. Section 2106 of the MPEP discusses the patentability of computer-related inventions. The MPEP states, “[i]n this context, ‘functional descriptive material’ consists of data structures and computer programs which impart functionality when employed as a computer component. **When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases** since use of technology permits the function of the descriptive material to be realized.” MPEP § 2106. (emphasis added) (citations omitted). There is no separate requirement for a “means of execution.”

The *Office Action* further states, “claims 23-30 fail to meet (sic) the tangibility requirements as the specification states, ‘Embodiments of CRM for memories 108 and 156 include, but are not limited to, an electronic, optical, magnetic, or other storage or transmission device,’ and transmission type media (i.e., carrier waves) are not tangible.” *Office Action*, page 3. A “carrier wave” is defined as “the radio frequency wave generated at a transmitting station for the purpose of carrying the modulated or audio frequency wave.” *Newton’s Telecom Dictionary*, 17<sup>th</sup> Edition, page 126.

Respectfully, Applicant is not claiming a carrier wave. Rather, Applicant claims “[a] computer-readable medium on which is encoded program code.” The program code may be embedded on any type of storage or transmission device. It may also be present in a signal, which is a modulated carrier wave.

As discussed above, the MPEP states that when a computer program is “...recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases...” MPEP § 2106. (citations omitted). And signals are not per se unpatentable. The Supreme Court found a claim for a signal to be patentable subject matter in 1854 when it upheld such a claim in one of Samuel Morse’s telegraph patents.

See *O'Reilly v. Morse*, 56 U.S. 62 (1854). Signals are “physical” and “useful, concrete and tangible,” and are thus as patentable as any other object in the physical world. In *State Street*, the Federal Circuit noted that the claimed subject matter in *Alappat* “constituted a practical application of an abstract idea ... because it produced ‘a useful, concrete and tangible result’ – the smooth waveform.” *State Street Bank and Trust v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 31 USPQ2d 1596, 1601 (CAFC 1998). The court in *State Street* explicitly stated that the “smooth waveform” in *Allapat*, which is a man-made signal, is “useful concrete and tangible.” *Id.* Further, the MPEP states “...a signal claim directed to a practical application of electromagnetic energy is statutory regardless of its transitory nature.” MPEP § 2106(B)(1)(c) (8th ed., Rev. Aug. 2006) (citing *O'Reilly*, 56 U.S. at 114-19; *In re Breslow*, 616 F.2d 516, 519-21, 205 USPQ 221, 225-26 (CCPA 1980)). Program code embedded in a computer-readable medium is a practical application of electromagnetic energy.

For the reasons stated herein, Applicant respectfully request that the Examiner withdraw the rejections of claims 1-30 under 35 U.S.C. § 101.

**V. Claims 1, 2, 3, 5, 9, 23-25, and 28 stand rejected to under 35 U.S.C. § 102(e)**

Claims 1, 2, 3, 5, 9, 23-25, and 28 stand rejected to under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Publication No. 2005/0222975 to Nayak (hereinafter “Nayak”).

In order to anticipate a claim under 35 U.S.C. § 102, a reference must teach every element of a claim. M.P.E.P. § 2131. Respectfully, Nayak does not teach every element of the rejected claims.

In claim 1, as amended, Applicant claims a method comprising “receiving a first search query having a first content, the first content comprising a plurality of components.” Nayak does not disclose a “first content comprising a plurality of components.” Instead, Nayak discloses a system utilizing a single keyword. See, e.g., paragraph 0068. Thus, claim 1 is patentable over Nayak. Claims 2, 3, 5, and 9 depend from and further limit claim 1 and are thus also patentable over Nayak for at least the same reasons.

In claim 23, as amended, Applicant claims a computer-readable medium comprising “program code for receiving a first search query having a first content, the first content comprising a plurality of components.” As discussed above, Nayak does not disclose a “first

content comprising a plurality of components.” Thus, claim 23 is patentable over Nayak. Claims 24, 25, and 28 depend from and further limit claim 23 and are thus patentable over Nayak for at least the same reasons.

Thus Applicant respectfully requests that the Examiner withdraw the rejections of claims 1, 2, 3, 5, 9, 23-25, and 28.

**VI. Claims 1-10, 20, and 22-30 stand rejected under 35 U.S.C. § 102(b)**

Claims 1-10, 20, and 22-30 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. 6,006,225 to Bowman (hereinafter “Bowman”).

In order to anticipate a claim under 35 U.S.C. § 102, a reference must teach every element of a claim. M.P.E.P. § 2131. Respectfully, Bowman does not teach every element of the rejected claims.

In claim 1, as amended, Applicant claims a method comprising “issuing a search of the modified second search query having the substituted modified search query to return one or more search results as responsive to the received second search query.” Bowman does not teach “issuing a search of the modified second search query.” Bowman teaches a process for correlating a first term or terms in a query with a second term that was associated with that first term in previously-executed queries. See Col. 10:7-10. The resulting queries are displayed. The queries are not “issued...to return search results...” as is claimed in claim 1. Thus Bowman does not anticipate claim 1. Claims 2-10, 20, and 22 depend from and further limit claim 1 and are thus patentable for at least the same reasons.

In claim 23, as amended, Applicant claims a computer-readable medium comprising “program code for issuing a search of the modified second search query having the substituted modified search query to return one or more search results as responsive to the received second search query.” As discussed above in relation to claim 1, Bowman does not teach “issuing a search of the modified second search query.” Thus Bowman does not anticipate claim 23. Claims 24-30 depend from and further limit claim 1 and are thus patentable for at least the same reasons.

Thus Applicant respectfully requests that the Examiner withdraw the rejections of claims 1-10, 20, and 22-30.

**VII. Claims 11-19 and 21 under 35 U.S.C. § 103(a)**

Claims 11-19 and 21 stand rejected as being allegedly unpatentable over Bowman in light of Nayak. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references must teach or suggest all of the claim limitations. Claims 11-19 and 21 depend from claim 1. As discussed above, neither Bowman nor Nayak, alone or in combination, disclose all of the limitations of independent claim 1. Thus claims 11-19 and 21 are patentable over Bowman in light of Nayak for at least the reasons stated above. Accordingly, Applicant respectfully request the Examiner withdraw the rejections of claims 11-19 and 21.

**VIII. Conclusion**

Applicant respectfully submits that the pending claims are allowable. Applicant respectfully solicits the issuance of a timely Notice of Allowance for all pending claims. The Examiner is invited to contact the undersigned by telephone to discuss any matter related to the Application.

Respectfully submitted,

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